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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,803	10/07/2003	Laurent P. Kosbach	03092CON	6636

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03/29/2007

EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/681,803	Applicant(s) KOSBACH ET AL.	
	Examiner Isis A. Ghali	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/07/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examination of this application has been transferred from examiner Jyothsna Venkat to examiner Isis Ghali.

The receipt is acknowledged of applicants' election filed 01/19/21007, and IDS . filed 10/07/2003.

Response to Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-12, in the reply filed on 01/19/2007 is acknowledged. The traversal is on the ground(s) that Groups I, II, and III are of the same search class and any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Groups II and III and if the composition claims of elected Group I are determined to be patentable, then the use thereof as recited in the claims of Groups II and III must be novel and unobvious. Additionally, applicants argue that there would be no serious burden on the Examiner to search and examine all of the subject matter encompassed by the pending claims at the same time.

This is not found persuasive because according to MPEP § 806.05(h) the inventions are distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product

Art Unit: 1615

or (2) the product as claimed can be used in a materially different process of using that product, and in this case the product of Group I as claimed can be used in two distinct process evidenced by applicants themselves. The process as claimed can be also practiced using boron nitride particles. Groups II-III encompass methods that are distinct functionally and are not required one for the other. Groups II-III utilize a common product, but comprise substantively different method steps and achieve different goals. Therefore search and examination of both the methods along with the product in one patent application would result in an undue burden, since the search for the three methods are not co-extensive. Accordingly, the prior art that anticipates one Group may not anticipate the other. Regarding the burden on the patent examiner, the search system and the focus of the invention are completely different, requiring an undue burden on the patent examiner. While searches may seem to be overlapping, however it is extensive since the patent examiner searches the databases mostly literally. Rarely do applicants present claims to an inventions where the distinctness of the invention are readily clear such as a chemical compound and a gene sequence. It is the responsibility of the examiner to enforce 35 USC 101, which allows the applicant to obtain a patent for a single invention. In the opinion of the examiner the applicants present three distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-36 are withdrawn from further consideration pursuant to 37 CFR

1.142(b), as being drawn to a nonelected inventions II and III, there being no allowable

Art Unit: 1615

generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/19/2007.

Claims 1-12 are included in the prosecution.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 14-25, and 27-38 of copending Application No. 10/959,614. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "soft-focus" does not set out the metes and bounds of the claim. Recourse to the specification does not define the expression.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 1615

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0064020 ('020) by itself or in view of US 6,333,053 ('053).

US '020 teaches alumina particles having δ and θ crystalline form with primary particles thereof having average particle diameter of 5 to 100 nm and secondary particles resulting from aggregation of primary particles having average particle diameter of 50-800 nm (abstract; paragraphs: 0012, 0013, 0029). The primary particles are loosely aggregated to form secondary particles (paragraph 0079), which reads on fumed alumina because applicants disclosed on page 3, paragraph 0016 that fumed alumina is used to refer to alumina primary particles that aggregate to form larger particles. The reference disclosed the use of alumina particles for cosmetic application (paragraph 0079). The reference further disclosed alumina particles having particle diameter larger than $45\ \mu\text{m}$ (paragraph 0014). The reference disclosed that the particles having diameter larger than $45\ \mu\text{m}$ are contained in an amount about 0.05%, i.e. the particles having diameter less than $45\ \mu\text{m}$ is present in an amount of 99.05%, which meet the requirement of claims 7, 10 and 11. Regarding claim 12, the reference disclosed the particles are mixed form of δ and θ crystalline alumina particles, i.e. 100% of the particles are mixed form, which reads on the limitation of claim 12 that 30% or more are combined δ and θ crystalline particles.

US '020 does not teach the amount of fumed alumina in the composition as claimed by claim 1.

However, the claimed amount does not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles as taught by US '020, and adjust the amount of the particles in the composition according to the specific intended use with reasonable expectation to arrive to the claimed amount of alumina particle in cosmetic composition.

US '053 teaches cosmetic composition comprising particles of metal oxides including aluminum oxide in a preferred amount of 2 to 15% that provides advantageous application makeup for skin, nail and mucous membranes of the human being (abstract; col.2, lines 32-35, 55-63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles as taught by US '020, and adjust the amount of the particles in the composition to the range between 2 and 15 % as disclosed by US '053, motivated by the teaching of US '053 that amount of the particles in the cosmetic composition between 2-15% is preferred because it provides advantageous application makeup for skin, nail and mucous membranes of the human being, with reasonable expectation of having

Art Unit: 1615

cosmetic composition comprising 2-15% of alumina particles wherein the composition provides advantageous application makeup for skin, nail and mucous membranes of the human being.

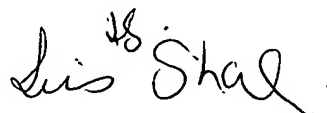
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ISIS GHALI
PRIMARY EXAMINER

Isis A Ghali
Primary Examiner
Art Unit 1615

A handwritten signature in cursive script, appearing to read "Isis A. Ghali", with a small "18" written above the "i" in "Isis".